

**REMARKS**

In response to the final Office Action mailed April 20, 2004, claims 1-11 are pending. No claims have been amended, cancelled, or added. In view of the following comments, reconsideration and allowance of all the rejected claims are respectfully requested.

Regarding the Information Disclosure Statements (IDSs) originally filed on September 7, 1999 and September 20, 1999, and resubmitted on August 27, 2003, Applicant thanks the Examiner for considering the listed references as acknowledged by the signed and initialed forms PTO-1449. However, applicant notes that references 66 through 78 on page 3 of 13 of the Form PTO-1449 have not been initialed, and respectfully requests that the Examiner consider the references cited therein and return a signed copy of the corresponding Form PTO-1449, page 3, in the next Office Action.

Reconsideration and allowance of all the rejected claims are respectfully requested.

***Claim Rejections under 35 U.S.C. §102***

Claims 1-6, 9, and 10 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Barnett et al. (USP 6,321,208). Applicant respectfully traverses this rejection on the following basis.

Independent claim 1 recites an in-store redemption system having a first generating means for printing a coupon, in response to a command input by the consumer, based upon the virtual coupon data corresponding to the consumer identification data of the consumer using the in-store redemption system, among other things. An exemplary embodiment provides for an in-

store computer kiosk that receives a consumer's authorization number that is provided to each consumer who has used the SELLECTSOFT<sup>TM</sup> software on his or her own home computer (see page 32, line 26 to page 33, line 5, of the specification). The computer kiosk may receive data to check for virtual coupons accredited to his or her account and may also provide a selection of goods that may be purchased at the retail location of the computer kiosk(see page 33, lines 6-10, of the specification). In an additional embodiment, the computer kiosk may print the virtual coupons.

Section 2131 of the MPEP states that "[a] claim is anticipated only if each and every element as set forth in the claim is expressly or inherently described, in a single prior art reference," (quoting *Verdegaal Bros. V. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987)). The Examiner admits that, "Barnett does not expressly disclose using...an in-store redemption system," (see page 5, lines 19 and 20 of the Final Office Action).

Since the Examiner admits that Barnett does not expressly teach an in-store redemption system, the Examiner's position must be that the missing element(s) are *inherently* described in the reference (see MPEP § 2131). However, "the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP § 2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993)). Thus, to inherently disclose an in-store redemption system, the system disclosed by Barnett *must* include an in-store redemption system in order to function properly. The Applicants submit that this is not the case. Rather, Barnett discloses prior art systems, such as, a teaching that the U.S. Patent No. 5,176,224 to Spector ("Spector") suggests "a closed-loop coupon system...located at a retail store" (see Final Office Action at page 6 lines 5-7). Barnett teaches away from in-store

printing by providing a home printing system. While Barnett appears to suggest that in-store printing, in general, was known, Barnett does not suggest combining the in home printing system that is disclosed with an in-store system. In other words, Barnett does not incorporate the alleged teachings of the prior art references, such as Spector, into the home printing system disclosed in Barnett.

Even if the Examiner's assertion with respect to the disclosure of Barnett is true, such a teaching would not have been sufficient to support a rejection of the claimed invention based on the inherent presence of an in-store redemption system in the system disclosed by Barnett. The Examiner must show that the system of Barnett would not function without an in-store redemption system in order to prove inherency.

Further, the Examiner contends that one of ordinary skill would have been motivated to include an in-store redemption system in the system of Barnett to optimize the system of Barnett (see the Final Office Action at page 7, line 5 – page 8, line 20). The Applicants argue that this contention is inappropriate in a rejection based on 35 U.S.C. § 102(e). Motivation and alteration are moot in such a rejection since optimization, such as rendering “a coupon delivery or distribution system more flexible and readily accessible to a consumer,” (see the Final Office Action at page 8, lines 7 and 8) is not relevant to the inquiry of inherency (see MPEP § 2112). Therefore, independent claim 1 is allowable over the references applied by the Examiner.

Dependent claims 2-6, 9, and 10 depend from, and add features to, independent claim, and are allowable at least by virtue of this dependency.

Claim 11 stands rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Barnett et al. (USP 6,321,208). Applicant respectfully traverses this rejection on the following basis.

Independent claim 11 recites, among other things, a reviewing module that analyzes a database in real-time during checkout to determine whether a code identifying a selected product is eligible for virtual coupon discount redemption. An exemplary embodiment of this feature may include using a SELECTSOFT™ database repository to determine whether a product is eligible for Virtual Coupon™ discount redemption (see the instant application at page 45, lines 15-22).

At best, Barnett merely discloses that “the coupon redemption center receives from a number of stores 10 the coupon redeemed, verifies the value of the redeemed coupon, determines the identification of users who redeemed the coupons, and distributes the information read from the coupons 18 to the individual coupon issuers 14 and to the coupon distributor” (see Barnett et al., col. 7, lines 36-40). However, Barnett does not suggest a reviewing module that analyzes a database in real-time during checkout to determine whether a code identifying a selected product is eligible for virtual coupon discount redemption. Therefore, the disclosure of Barnett does not teach or suggest all the elements of the claimed invention.

Since Barnett et al. neither discloses nor suggests the invention claimed in independent claim 11, it clearly is not anticipated by the disclosure of Barnett. For the foregoing reason, claim 11 is allowable over the references applied by the Examiner.

*Claim Rejection under 35 U.S.C. §103*

Claims 7 and 8 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Barnett et al. Applicant respectfully traverses this rejection on the following basis

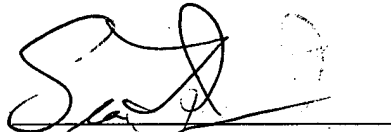
Dependent claims 7 and 8 depend from claim 1, and thus include the recitation of an in-store redemption system having a first generating means for printing a coupon, in response to a command input by the consumer, based upon the virtual coupon data corresponding to the consumer identification data of the consumer using the in-store redemption system, among other things. The Examiner has taken "Official Notice" that providing a user with a data entry means to a user to access a secure system was well known in the art (see the Final Office Action at page 12, lines 11-14). Even if this assertion by the Examiner is true, it does not cure the admitted deficiency of Barnett with respect to an in-store redemption system having a first generating means for printing a coupon, in response to a command input by the consumer, based upon the virtual coupon data corresponding to the consumer identification data of the consumer using the in-store redemption system, as has been addressed above. Therefore, claims 7 and 8 are allowable over the references applied by the Examiner.

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned attorney at the number provided.

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Respectfully submitted,



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